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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/522,709	03/10/2000	Fernando L. Alvarado	43920-032	5984
20277	7590	06/28/2004	EXAMINER	
MCDERMOTT WILL & EMERY LLP 600 13TH STREET, N.W. WASHINGTON, DC 20005-3096			SNAPP, SANDRA S	
			ART UNIT	PAPER NUMBER
			3624	

DATE MAILED: 06/28/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)
	09/522,709	ALVARADO ET AL.
	Examiner Sandra Snapp	Art Unit 3624 <i>MW</i>

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) Responsive to communication(s) filed on 05 April 2004.
- 2a) This action is FINAL. 2b) This action is non-final.
- 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) Claim(s) 1-20 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) Claim(s) 18-20 is/are allowed.
- 6) Claim(s) 1-17 is/are rejected.
- 7) Claim(s) _____ is/are objected to.
- 8) Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) The specification is objected to by the Examiner.
- 10) The drawing(s) filed on _____ is/are: a) accepted or b) objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
 - a) All b) Some * c) None of:
 1. Certified copies of the priority documents have been received.
 2. Certified copies of the priority documents have been received in Application No. _____.
 3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____. |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____. | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| | 6) <input type="checkbox"/> Other: _____. |

Response to Amendment

This Office Action is in response to the Amendment filed on 4-5-4. Currently, claims 1-20 are pending in the application.

Claim Objections

The objection of claim 7 is maintained. Claim 7 was previously objected to because it contained the phrase “producing portfolio” in line 6, wherein the phrase should be “producing *a* portfolio.” Appropriate correction is required.

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 4, 9, 10, 12, 13, 15, 16, 19 and 20 were previously rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. The prior rejection of claims 4, 9, 10, 12, 13, 15, 16, 19 and 20 is herein withdrawn in view of the amendment dated 4-5-4.

However, claims 1-4, 10, 13 and 14-17 are now newly rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claims 1, 14 and 17 are indefinite because they are incomplete since they omit essential elements, such omission amounting to a gap between the elements. See MPEP § 2172.01. The omitted elements are the necessary nexus between producing a combination of price risk instruments and how the commodity is reduced. In other words, how is the commodity reduced when the price risk instrument is produced? It is unclear how the step of producing the price risk instrument leads to the commodity being reduced. Clarification is required.

Claims 2-4, 15 and 16 are indefinite because they depend from rejected base claims 1 and 14.

Claims 4, 10, 13 and 16 are also indefinite because the phrase “take financial advantage” is vague. It is unclear what is meant by “take financial advantage?” The Examiner is unable to determine the scope of the claim because she cannot determine what the phrase “take financial advantage” does not specifically define what the metes and bounds of the claim are.

Claim Rejections - 35 USC § 101

35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

Claims 1-16 remain rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter. The claims do not recite any technology in the body of the claims. The Board of Patent Appeals and Interferences has taken the position that a claim that lacks any specific technology is “nothing more than [an]

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abstract idea which is not tied to any technological art and is not a useful art as contemplated by the Constitution.” *Ex party Bowman*, 61 USPQ2d 1669, 1671 (Bd. Pat. App. & Inter. 2001) (Unpublished). While it is understood that the Bowman decision is nonprecedential, it is cited herein for its content and reasoning. The Examiner appreciates the Applicant’s comments on the requirement under 101 for technology and their incorporation of such language into the preamble, however it is the Patent Office’s position that some reference to technology must be embodied in the body of the claim, such recitations in the preamble are not sufficient.

Allowable Subject Matter

Claims 17 & 18 were previously indicated as allowed. Such allowance is herein withdrawn in view of the present Office Action.

Claims 18-20 are now indicated as being allowed.

The following is a statement of reasons for the indication of allowable subject matter: none of the prior art of record shows or teaches a computer readable medium with instructions for estimating a plurality of distribution factors indicating effects on one or more congestible lines, and evaluating a portfolio based on the estimated distribution factors (claim 18) and a portfolio comprising a plurality of price risk instruments wherein such instruments are proportioned such that $z' A - y' P' A = 0$.

Conclusion

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. The Roberts et al., Johnson et al., Knoblock et al., Crooks et al.,

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Spalti, Ishimaru et al., Williams, Oravetz et al., Fink, Chasek, Takriti et al. and Bond et al. patents all are directed to various electronic systems that deal with electric power.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Sandra Snapp whose telephone number is 703-305-6940. The examiner can normally be reached on Mon.-Thurs.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Vincent Millin can be reached on 703-308-1065. The fax phone number for the organization where this application or proceeding is assigned is (703) 872-9306.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-1113.

ss

Sandra Snapp
SANDRA S. SNAPP
PATENT EXAMINER
GROUP 3600